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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,725	10/09/2001	Shiho Wang	SITECH.004A	7828

20995 7590 08/08/2003

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EXAMINER
LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
1712	8

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary	Application No. 09/975,725	Applicant(s) WANG ET AL
	Examiner LOVERING	Group Art Unit 1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on JAN. 14, FEB 4 & 8 AND JULY 16, 2002 .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-50 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-50 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The drawing(s) filed on 10/09/01 is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachm nt(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4-17

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Acti n Summary

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 42-44 and 46-48 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Johnson 2,092,163, Examples 1 and 2.

4. Claims 42-48 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Haensel et al. 2,794,002, Example I.

5. Claims 36 and 50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Vozka et al. 4,104,363. The instantly-claimed gel

monoliths are anticipated by Vozka et al. (Example 5 referring to Example 4), or are at least clearly within the purview of Vozka et al., and thus would have been obvious therefrom to one having ordinary skill in the art at the time applicants' invention was made. As to claim 36 herein, the product-by-process terminology has not been shown to be materially or patentably distinguishing. See In re Marosi, 710 F. 2d 799; and In re Thorpe, 777 F. 2d 695. As to claim 50 herein, note the penultimate sentence of Example 5, which in the very least would suggest a standard deviation of less than 50 Angstroms.

6. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 50 is rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for metal oxide monoliths, does not reasonably provide enablement for organic substance monoliths, such as gelatin, cellulose, etc. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The chemistry of metal oxides and organic substances is

very different and so are the factors controlling their microstructures, and applicants have given no guidance or direction concerning organic gel monoliths and their production. It would involve undue experimentation on the part of one having ordinary skill in the art to prepare organic gel monoliths having the parameters recited in the stated claim.

8. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-41, 49 and 50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending application Serial No. 10/117,921. Although the conflicting claims are not identical, they are not patentably distinct from each other because the stated instant claims at least overlap the claims of the '921 application because said instant claims in

"comprising" do not exclude the step of drying the wet gel monolith.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "24" in Fig. 3F has been used to designate both a tube or hose and bubbling nitrogen vapor. Correction is required.

11. The remaining references listed on the attached Forms PTO-1449 (four sheets) are cumulative to the references applied herein, and/or further show the state of the art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
August 6, 2003

Richard D. Lovering
RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1700